



MAR 30 2009

Facsimile Cover Sheet
Patent Department

TODAY'S DATE: March 30, 2009

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THIS MESSAGE IS FROM:

Name: Richad C. Billups
Phone No.: (732)594-4683 Mail Location: RY60-30
Fax No.: (732)594-2300

Appl'n. No.: 10/556,230
Filing Date: November 9, 2005
Docket No.: 21241P
For: BENZIMIDAZOLES, COMPOSITIONS CONTAINING SUCH COMPOUNDS
AND METHODS OF USE

NUMBER OF PAGES BEING TRANSMITTED (INCLUDING COVER): 5

Documents sent:

Cover Sheet (1pg.) and Petition (3 pgs.) and Fee Transmittal (1 pg)

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MAR 30 2009

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:	Emma R. Parmee et al.	
Serial No.:	10/556,230	Case No.: 21241P
Filing Date:	November 9, 2005	
For:	BENZIMIDAZOLES, COMPOSITIONS CONTAINING SUCH COMPOUNDS AND METHODS OF USE	

Art Unit:
1626

Examiner:
Kamal A. Saced

Office of Petitions
Honorable Commissioner of Patents
Alexandria, VA 22313-1450

PETITION PURSUANT TO 37 C.F.R. § 1.181 AND
APPLICATION FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT
PURSUANT TO 37 C.F.R. § 1.705

Sir:

This Petition is filed pursuant to 37 C.F.R. § 1.705 seeking reconsideration of the period of patent term adjustment awarded by the Patent Office in the captioned patent application.

STATEMENT OF FACTS

- 1) The captioned patent application is a U.S. National Phase application filed under 35 USC 371. The U.S. National Phase filing date was November 9, 2005.
- 2) The Patent Office issued a Restriction Requirement on September 5, 2008, 605 days after the filing date. The 14-month cutoff for purposes of calculating delay under 37 CFR 1.703(a)(1) is January 7, 2007. The PTO calculation of delay as 605 days was correct.
- 3) A response to the Restriction Requirement dated September 5, 2008 was filed via facsimile on October 2, 2008.

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Serial No.: 10/556,230
Case No.: 21241P
Page No.: 2

- 4) Applicants also submitted an IDS on March 26, 2007, and a second IDS on November 26, 2007, via regular U.S. mail. The first IDS and references were indicated as received in the Patent Office on March 27, 2007. The second IDS was received in the Patent Office on November 28, 2007.
- 5) The Patent Office issued a Restriction Requirement on September 5, 2008. Applicants responded to the Restriction Requirement on October 10, 2008 via facsimile.
- 6) A Notice of Allowance was mailed by the Patent Office on December 30, 2008. The Issue Fee is due March 30, 2009. The Issue Fee is being submitted to the Patent Office with this Petition.
- 7) This patent is not subject to a terminal disclaimer.
- 8) There were no instances in which Applicants failed to respond to an Official Action within the prescribed time frame. Consequently, a fee as set forth in 37 C.F.R. § 1.18(f) and a showing of the use of "all due care" under 37 C.F.R. § 1.705(c)(2) are not required.

ARGUMENTS IN SUPPORT OF PETITION

The Patent Office has not provided any indication of patent term adjustment for delay beyond the date that is three years after the 371(c) filing or completion date, i.e., no determination has been made taking into account delay under 37 C.F.R. § 1.703(b).

Under *Wyeth v. Dudas*, No. 07-1492 (D.D.C. 2008), a patentee is entitled to both any "(a) period" delay and any "(b) period" delay. According to *Wyeth*, 35 U.S.C. § 154 establishes that a patent term is 20 years from the earliest relevant filing date of a patent application. Because patentees do not benefit from patent term during prosecution, § 154(b)(1) further provides a patent term adjustment (PTA) to account for delays by the Patent Office under certain circumstances. For example, the statute provides a one-day extension of term for every day corresponding to an "(a) delay," that is, where the Patent Office fails to meet particular deadlines such as issuing a first Office Action within 14 months, responding to a reply within four months, and so forth. In addition, the statute addresses a "(b) type delay" by giving a one-day extension of term for every day of prosecution that occurs three years after the filing date.

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MAR 30 2009

Serial No.: 10/556,230
Case No.: 21241P
Page No.: 3

To prevent double-counting, 35 U.S.C. § 154 dictates that, *to the extent that "(a) delays" and a "(b) delay" overlap, the patent term adjustment "shall not exceed the actual number of days the issuance of the patent was delayed." § 154(b)(2)(A).* (emphasis added). The Patent Office has interpreted this language to mean that a patentee may obtain credit for "(a) delays" or a "(b) delay," whichever is larger, but not (a) + (b). According to the Patent Office prior to Wyeth, any period of "(b) delay" necessarily overlaps with any periods of "(a) delays." The District Court in Wyeth held that only actually overlapping days should be subtracted.

Since the three year date for this application occurred on November 9, 2008, and since there were no type (a) delays by the Patent Office after this date, the (b) period can be calculated as a day-for-day extension from November 9, 2008, until the date that the patent issues, less any time that the Patent Office deems Applicants to have been non-diligent in advancing prosecution.

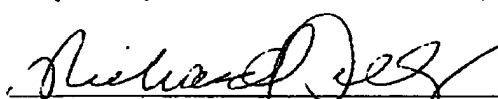
CONCLUSION

Applicants urge that the correct Patent Term Adjustment is 605 days plus the full period of time calculated from the date that is the three years after the filing date, i.e., November 9, 2008, until the patent is granted.

Enclosed herewith is an authorization to charge deposit account 13-2755 the \$200.00 fee required under § 1.18(e).

Respectfully submitted,

By



Richard C. Billups, Reg. No. 31,916
Attorney for Applicants

MERCK & CO., Inc.
P.O. Box 2000
Rahway, New Jersey 07065-0907
Tel: (732)594-4683

Date: March 30, 2009

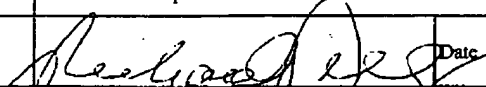
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MAR 30 2009

MISC. FEE TRANSMITTAL <i>Patent fees are subject to annual revision.</i>		<i>Complete if Known</i>	
		Application Number	10/556,230
		Filing Date	November 9, 2005
		First Named Inventor	Emna R. Parmee
		Examiner Name	Kamal A. Saeed
		Group Art Unit	1626
TOTAL AMOUNT OF PAYMENT		\$200	Attorney Docket Number
			21241P

METHOD OF PAYMENT	
<input checked="" type="checkbox"/> Deposit Account	
Deposit Account Number	13-2755
Deposit Account Name	Merck & Co., Inc.
The Director is authorized to:	
<input checked="" type="checkbox"/> Charge fee(s) indicated below	
<input checked="" type="checkbox"/> Credit any overpayments	
<input checked="" type="checkbox"/> Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17	

FEE CALCULATION			
FEES			
Large Entity			
Fee Code	Fee (\$)	Fee Description	Fee Paid
1051	130	Surcharge - late filing fee or oath	
1053	130	Non-English Specification	
1812	2,520	For filing a request for <i>ex parte</i> reexamination	
1402	540	Filing a brief in support of an appeal	
1452	540	Petition to revive - unavoidable	
1453	1,620	Petition to revive - unintentional	
1807	50	Processing fee under 37 CFR 1.17(q)	
1806	180	Submission of Information Disclosure Statement	
1809	810	Filing a submission after final rejection (37 CFR 1.129(a))	
1810	810	For each additional invention to be examined (37 CFR 1.129(b))	
1814	140	Statutory Terminal Disclaimer under 37 CFR 1.321	
Other fee (specify)		Request for Reconsideration of the Patent Term Adjustment	200
Other fee (specify)			
TOTAL			\$200

SUBMITTED BY		Complete (if applicable)	
Typed or Printed Name	Richard C. Billups	Reg. Number	31,916
Signature		Date	03/30/2009
		Deposit Account User ID	